

### **REMARKS**

Applicants acknowledge receipt of the Office Action dated May 13, 2008. In that action, the Examiner: (1) rejected claims 7-14 under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,029,748 to Forsyth et al. ("*Forsyth*") in view of U.S. Patent No. 5,427,698 to Hirokawa et al. ("*Hirokawa*"); and (2) rejected claims 149-152 under 35 USC §1.03(a) as being unpatentable over *Forsyth* in view of *Hirokawa* and U.S. Patent No. 5,034,508 to Nishizaki et al. ("*Nishizaki*"). Reconsideration is respectfully requested in view of the attached amendments and remarks that follow.

#### ***Rejection of Claims 7-14***

The Examiner rejected claims 7-14 under 35 USC §103(a) as being unpatentable over *Forsyth* in view of *Hirokawa*. Applicants have amended independent claims 7, 9, 11, and 13 to include, in part, a lubricant coupled to the interior surfaces of a tubular member, wherein the lubricant comprises "a dry lubricant material in an amount less than 20% by weight." Claims 8, 10, 12, and 14 depend from claims 7, 9, 11, and 13, respectively. For consistency, dependent claims 8, 10, 12, and 14 have been amended to include "1 to less than 20%, polytetrafluoroethylene."

To support an obviousness rejection under § 103(a), the combination of *Forsyth* and *Hirokawa* must teach or suggest every feature of the claims. Applicants respectfully submit that neither *Forsyth* nor *Hirokawa* teaches or suggests a lubricant coupled to the interior surfaces of a tubular member, comprising less than 20% dry lubricant material by weight. The Examiner correctly states that *Forsyth* does not disclose lubricant composition. The Examiner then states that *Hirokawa* discloses "a coating composition for lubrication including...a dry lubricant material in 1 to 25% polytetrafluoroethylene." *Office Action*, Page 2. However, the Examiner has attributed a broader range than is actually disclosed by *Hirokawa*. In fact, *Hirokawa* discloses a solid lubricant in an amount of 20 to 80% by weight. *Hirokawa*, col. 2, ll. 67-68. *Hirokawa* does not disclose dry lubricant material in an amount less than 20% by weight. Furthermore, *Hirokawa* does not suggest a dry lubricant material less than 20% because *Hirokawa* teaches away from using dry lubricant material in an amount less than 20% by weight. Specifically, *Hirokawa* states

“when the amount of solid lubricants incorporated is less than 20% by weight, there will be resulted insufficient withstand load, fitting and feeling.” *Hirokawa*, col. 3, ll. 2-4.

Therefore, one having ordinary skill in the art would not find obvious the claimed arrangement over the combined disclosures of *Forsyth* and *Hirokawa*. As stated above, the Examiner has failed to show that *Forsyth* and *Hirokawa* disclose or suggest using a dry lubricant material in an amount less than 20% by weight. Applicants respectfully submit that amended claims 7-14 are not obvious and allowable over the cited art.

### ***Rejection of Claims 149-152***

The Examiner rejected claims 149-152 under 35 USC §103(a) as being unpatentable over *Forsyth* in view of *Hirokawa* and *Nishizaki*. Applicants respectfully submit that claims 149-152 are allowable as written because they depend from now allowable independent claims 7, 9, 11, and 13, respectively. As stated, *Forsyth* and *Hirokawa* do not disclose or suggest a lubricant coupled to the interior surfaces of a tubular member, comprising less than 20% dry lubricant material by weight. Further, *Nishizaki* does not include any teaching to supplement this deficiency in the base combination. For at least this reason, Applicants respectfully submit that claims 149-152 are not obvious over *Forsyth* in view of *Hirokawa* and *Nishizaki* under 35 U.S.C. 103(a).

### **CONCLUSION**

In the course of the foregoing discussions, Applicants may have at times referred to claim limitations in shorthand fashion, or may have focused on a particular claim element. This discussion should not be interpreted to mean that the other limitations can be ignored or dismissed. The claims must be viewed as a whole, and each limitation of the claims must be considered when determining the patentability of the claims. Moreover, it should be understood that there may be other distinctions between the claims and the cited art which have yet to be raised, but which may be raised in the future.

Applicants respectfully request reconsideration and that a timely Notice of Allowance be issued in this case. No new matter is introduced by way of amendment. It is believed that each ground of rejection raised in the Office Action dated May 13, 2008 has been fully addressed. If any item has been overlooked, Applicants respectfully request the opportunity to supplement this

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response. If the Examiner feels that a telephone conference would expedite the resolution of this case, the Examiner is respectfully requested to contact the undersigned.

It is believed that no extensions of time or fees are required. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 C.F.R. § 1.136(a), and any fees required (including fees for net addition of claims) are hereby authorized to be charged to USPTO Deposit Account No. 50-3953 (2725-31800).

Respectfully submitted,

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